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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,514	07/20/2001	Scott Hillstrom	P/25-7	9677

7590 07/08/2004

WEISS & WEISS  
SUITE 305  
500 OLD COUNTRY ROAD  
GARDEN CITY, NY 11530

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,514

Applicant(s)

HILLSTROM, SCOTT

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-10 have been examined.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,4,6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "happening of certain events" fails to distinctly define any limitation of the claimed invention.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel et al. (US Patent No 5,592,549) in view of McClure, et al. (US Patent Application Publication No US 2003/0208395).

As per claim 1,

Nagel et al., ('549) discloses a method for protecting electronic files from being forcibly accessed by legal process comprising;

allowing access by one or more memory storage devices located in jurisdictions that do not enforce said process of one or more other jurisdictions whose process a party wishes to protect said information and files from;(Figure 7)

placing said information under exclusive physical and legal control of a trustee or equivalent who is duly appointed under laws of said jurisdiction where said device or equivalent is located.(Figure 6)

Nagel et al., ('549) does not specifically disclose "creating and storing electronic files containing information" McClure, et al. ('395 discloses "creating and storing electronic files containing information"(Figure 1) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Nagel et al., ('549) method with the McClure, et al. ('395) method in order to efficiently store data..

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Claim 6 is in parallel with claim 1 and rejected for at least the same reasons.

As per claim 2,  
Nagel et al., ('549) discloses the method of claim 1 further comprising;  
transferring said files to another device and trustee in another jurisdiction upon  
happening of certain events.(Figure 6)

Claim 7 is in parallel with claim 2 and rejected for at least the same reasons.

As per claim 3,  
Nagel et al., ('549) discloses the method of claim 1.  
Nagel et al., ('549) does not specifically disclose "erasing permanently said files  
from said memory device from which they are transferred" McClure, et al. ('395  
discloses "erasing permanently said files from said memory device from which they are  
transferred"(Figure 3) It would be obvious to one having ordinary skill in the art at the  
time the invention was made to combine the Nagel et al., ('549) method with the  
McClure, et al. ('395) method in order to improve the security of the system.

Claim 8 is in parallel with claim 3 and rejected for at least the same reasons.

As per claim 5,  
Nagel et al., ('549) discloses the method of claim 2  
Official Notice is taken that "subpoena demanding production of information  
contained in said files stored on said device" is common and well known in prior art in  
reference to electronic files. It would have been obvious to one having ordinary skill in  
the art at the time the invention was made that a subpoena would be issued because this  
proper legal method for obtaining material relevant to legal proceedings.

Claim 10 is in parallel with claim 5 and rejected for at least the same reasons.

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the  
references as applied to the claims above for the convenience of the applicant. Although  
the specified citations are representative of the teachings of the art and are applied to the  
specific limitations within the individual claim, other passages and figures may apply as  
well. It is respectfully requested from the applicant in preparing responses, to fully  
consider the references in entirety as potentially teaching all or part of the claimed  
invention, as well as the context of the passage as taught by the prior art or disclosed by  
the examiner.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to John M Winter whose telephone number is (703) 305-  
3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

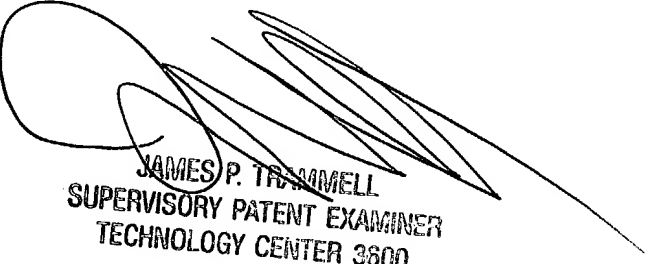
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW

June 27, 20044



JAMES P. TRAMMELL  
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